

Atty. Dkt. No. 10017724-1

REMARKS

This Reply is in response to the Office Action mailed on February 7, 2006. For the reasons which follow, Applicants respectfully request that the rejections of the claims be withdrawn.

I. Rejection of Claims 32-43 and 58 Under 35 U.S.C. § 101.

Paragraph 2 of the Office Action rejected Claims 32-43 and 58 under 35 U.S.C. § 101 as lacking patentable utility. Applicants traverse this rejection and request that this rejection be withdrawn for the following reasons.

The Office Action fails to establish a *prima facie* showing that the claimed invention lacks utility. As such, Applicants request withdrawal of this basis of rejection.

In particular, per USPTO practice, when the specification contains a disclosure of utility that corresponds in scope with the claimed subject matter the USPTO takes such disclosure as sufficient to satisfy the utility requirement under 35 USC § 101. In this regard, the MPEP states as follows.

As a matter of Patent Office practice, a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of § 101 for the entire claimed subject matter unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope. (emphasis in original) (MPEP 2107.02 (III) (A)).

Consequently, the initial burden is on the USPTO to establish a *prima facie* showing that the claimed invention lacks utility. MPEP 2107.02 IV. Specifically, to "properly reject a claimed invention under 35 U.S.C. 101, the Office must (A) make a *prima facie* showing that the claimed invention lacks utility, and (B) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing."

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In explaining the burden on the USPTO, the MPEP explains that the "*prima facie* showing must be set forth in a well-reasoned statement" and that any "rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility."

The showing in the present Office Action fails to satisfy the USPTO requirements of a *prima facie* showing that the claimed invention lacks utility. In this regard, the Office Action merely states as follows.

The claimed invention lacks patentable utility. The utility of the method is not set forth in the claim. The claimed invention, according to claims 32-43 and 58, lacks patentable utility. It describes a method but it is not clear what the method steps will function to achieve or perform. Office Action Paragraph 2.

Indeed, this statement is conclusory and does not begin to satisfy either of the requirements of the *prima facie* case as set forth above. Because the Office Action fails to establish a *prima facie* showing of a lack of utility, this basis of rejection is improper and should be withdrawn. Withdrawal of this rejection is requested.

Further, Applicants disagree with the statement in the Office Action that "[i]t describes a method but it is not clear what the method steps will function to achieve or perform." (Office Action, Paragraph 2. Applicants submit that the purpose, function, and utility of the claimed subject matter is well-described in the specification. Indeed, independent Claims 32 and 58 recite a method which includes generating a scanned image preview from image data corresponding to an image, defining the image region of the scanned image preview to retain and emulating a final scan of the image region to generate a final scanned image. Thus, the utility of the method recited in such claims is clear: generating a final scanned image through emulation.

To the extent the 35 USC § 101 rejections are based on an alleged lack of incorporation of the utility into the preamble of these claims, Applicants also traverse this basis. In short, for cases such as this, the patent statute (35 USC) does not

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require the claims have a preamble. Neither the CFR nor the MPEP require a claim preamble for cases such as this. Hence, for this case, the law does not require a claim preamble and any claim rejection based on a preamble requirement is improper and should be withdrawn.

In sum, because Office Action fails to establish a *prima facie* showing that the claimed invention lacks utility, the rejections based on 35 USC § 101 are improper. Further, because the specification provides ample description of the utility of the claimed subject matter and Office Action has not alleged otherwise, the rejections based on 35 USC § 101 are improper. Lastly, because for cases such as this, the law does not require a claim preamble, any rejection based on a preamble requirement is improper. As such, Applicants request withdrawal of this basis of rejection.

II. Rejection of Claims 32-43 and 58 Under 35 U.S.C. § 112, Para. 2.

Claims 32-43 and 58 stand rejected under 35 USC § 112, second paragraph as being indefinite. Applicants traverse this rejection.

The primary purpose of the definiteness requirement for claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention. MPEP 2173.

During examination, the test for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. MPEP 2173.02. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112,

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second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. *Id.*

Applicants note that Applicants may act as their own lexicographer and may use any style of expression or format of claims that makes reasonably clear the boundaries of the subject matter for which patent protection is sought. If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, 35 U.S.C. 112, second paragraph, demands no more. *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 225 USPQ 634 (Fed. Cir. 1985).

If, however, "upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made **and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action**". (emphasis added). MPEP 2173.02.

Applicants submit that the language used to recite the claimed subject matter adequately sets the boundaries of the claimed subject matter. The Office Action does not allege otherwise. As such, the rejection of these claims under 35 U.S.C. 112, second paragraph is improper.

Further, Applicants note that the Office Action fails to include any analysis as to why phrase(s) used in the claims are "vague and indefinite" as specified by MPEP 2173.02 (partially quoted in bold above). Because the Office Action fails to identify any language in the rejected claims that is indefinite, Applicants submit that the Office Action fails to establish a proper rejection of these claims under 35 U.S.C. 112, second paragraph. Withdrawal of these rejections is requested.

Rather than alleging that certain claim language is vague and indefinite, the Office Action states "[i]n the telephone conversation of December 22, 2005, the examiner relied upon 35 U.S.C. 100(b) and 37 C.F.R. 1.75(e)(1) in support for the

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position taken." Applicants submit that this is an improper basis for making a rejection under 35 U.S.C. 112, second paragraph.

In particular, 35 USC § 100(b) defines "process" as meaning "method" (among other things). Claims 32-43 and 58 are each directed to a "method" and thus could be characterized as a "process" according to the definition of 35 USC § 100(b). Applicants submit that 35 USC § 100(b) does not require every method claim to recite "a new use of a known process." Indeed neither § 112, second paragraph nor § 100(b) require a method claim to recite "a new use of a known process." As such, the Office Action statement that "Applicant has failed to recite a new use of a known process in the method claim" does not support a rejection under 35 USC § 112, second paragraph or under 35 USC § 101. Withdrawal of these rejections is requested.

In this regard, the Office Action at page 4 further states that "[h]aving submitted claims that meet the definition of Section 100(b), applicant has clearly not complied with Section 101." For at least the reasons set forth above, Applicants submit that because claims 32-43 and 58 are each directed to a "method" that these claims are within the Section 100(b) definition of "process". These claims are directed to a "method" which is expressly within the Section 100(b) definition of "process." Consequently, Applicants submit that this basis of rejection is improper.

The Office Action also makes reference to 37 C.F.R. 1.75(e) in connection with the 35 U.S.C. 112, second paragraph claim rejections. Applicants submit that does not impose any requirement on Applicants. The Office Action appears to concede this point and states "[a]pplicant is correct, however, the rule is a guide to what applicants' [sic] **should** do." (Emphasis in original). Hence, it appears agreed that 37 C.F.R. 1.75(e) does not impose a requirement on Applicants. Since 37 C.F.R. 1.75(e) does not require anything, Applicants submit that 37 C.F.R. 1.75(e) cannot be used as a basis to reject these claims under 35 U.S.C. § 112, second paragraph or under 35 USC § 101.

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In sum, the rejections under 35 U.S.C. § 112, second paragraph are improper because the Office Action fails to identify any language in the claim that is vague or indefinite. These rejections are further improper because in view of the fact that Applicants can be their own "lexicographer", the claims are definite, particularly when read in view of the rest of the specification. Moreover, these claims are directed to a "method" and as such, are expressly included in the § 100(b) definition of process. Lastly, since 37 C.F.R. 1.75(e), this section cannot be used to support a claim rejection under 35 U.S.C. § 112, second paragraph or 35 U.S.C. § 101. Withdrawal of these rejections is requested.

III. Rejection of Claims 57 and 58 Under 35 U.S.C. § 102(e) Based Upon Kumpf.

Paragraph 5 of the Office Action rejected claims 57 and 58 under 35 U.S.C. § 102(e) as being anticipated by Kumpf, U.S. Patent No. 6,289,371. For the reasons which follow, Applicants respectfully request that the rejection of Claims 57 and 58 based upon Kumpf be withdrawn.

A. Claim 57.

Claim 57 recites an imaging system which includes a component configured to generate a scanned image preview from image data corresponding to an image, an image region selection control configured for manipulation to select an image region of the scanned image preview to retain and an image region definition control configured for manipulation to define a classification of the image region, wherein the component is further configured to emulate a final scan of the image region to generate a final scanned image.

Kumpf fails to disclose an imaging system in which a region or portion of a scanned image preview is selectively chosen and retained, in which the selected region is classified and in which a final scan of the region is emulated. In contrast, Kumpf merely discloses carrying out a preview scan (see col. 7, lines 1-13), selecting a portion of the preview image (col. 7, lines 18-19), and subsequently carrying out a second final scan (see col. 7, lines 41-44). At page 7-8 of the Office

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Action, it is alleged that Kumpf discloses "emulating a final scan from a selected preview scan" at Col. 7, lines 14-22. Applicants submit that this section does not make any reference to "emulate" or to "emulating" and doesn't describe that the recited claim component is "configured to emulate a final-scan of the image region to generate a final scanned image."

Nowhere does Kumpf disclose or suggest defining a classification of a selected image region or portion of a preview image. At page 7 of the Office Action, the Office Action states that the "examiner contends that the classification referred to is paper size, image type, resolution, color or grey scale...." Applicants submit that this alleged "classification" is not a classification "of a selected image region or portion of a preview image" and as such, does not satisfy this claim limitation.

Moreover, nowhere does Kumpf disclose or suggest emulating a final scan of the selected region or portion of the preview scan to generate a final scanned image (see above). Once again, Kumpf specifically requires two distinct scans: (1) a first preview scan and (2) a second final scan. Accordingly, the rejection of Claim 57 based upon Kumpf is improper and should be withdrawn.

B. Claim 58.

Claim 58 is amended to recite "wherein the emulating the final-scan of the image region is performed without a re-scan of the image." Indeed, Kumpf employs multiple scans. Applicants submit that this limitation is not shown in Kumpf. Accordingly, Applicants request withdrawal of the rejection of claim 58.

IV. Conclusion.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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